



Attorney Docket # 3401-125RCE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Mark FREIER et al.

Serial No.: 10/002,523

Filed: November 2, 2001

For: Endoscopic Sample Taker for Cartilage Material

Examiner: Thaler, Michael H.
Group Art: 3731

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This is a Request for a Panel Review of Issues on Appeal in accordance with the Office Gazette Notice dated July 12, 2005. The present request is filed concurrently with a Notice of Appeal and is filed before an Appeal Brief. No amendments are being filed with this request.

Arguments supporting the Request for Review begin on page 2 of the present communication.

ARGUMENTS

This Notice of Appeal and Request is filed in response to the final Office Action dated July 13, 2006.

The matters to be reviewed are whether independent claims 8 and 17 are unpatentable over U.S. Patent No. 4,953,559 (Salerno) in view of U.S. Patent No. 4,569,131 (Falk).

Independent Claim 8

Independent claim 8 recites “said tongue being slidably adjustable so that said tongue slides along a longitudinal length of said tongue in response to axial adjustment of said actuating rod to an adjusted position between a closure position and an open position”.

The Examiner alleges that the combination of appendage 4, lever 5, and body 12 of Salerno comprises the recited “tongue” and that the parts 4, 5, 12 in Salerno “slide along a longitudinal length of the tongue”, as recited in independent claim 8. In contrast, the parts 4, 5, and 12 of Salerno pivot about a transverse axis instead of along a longitudinal length. More specifically, the appendage 4 and lever 5 are articulated about a transverse axis 8 (see col. 2, lines 57-62, of Salerno). The body 12 is an insulating material arranged between the lever 5 and the sides of the transverse notch 7 in the body 1 (col. 3, lines 6-13). Even if the movement of the portion 12 with lever 5 is considered to slide relative to the notch 7 of the body 1, this movement can not be considered to be “along a longitudinal length”, as recited in independent claim 8.

The Examiner recites a definition of the term “along” as “at a point or points on” (as in a house *along* a river). While that is indeed one of the definitions, the dictionary also includes another definition of “along” as “in a line matching the length or direction of”. The latter definition is the only appropriate one of the definitions given the context of the term “along” in claim 8, i.e., “slides along a longitudinal length of said tongue”. ^{However,} Even if the

Examiners definition of “along” is used, the combination 4, 5, 12 of Salerno can not be considered to slide along a longitudinal length of the tongue. Rather, the combination 4, 5, 12 of Salerno slides relative to the body 1 at points along a circumference relative to the transverse axis 8.

Independent Claim 17

Independent claim 17 recites “wherein said tongue comprises a thin strip having a longitudinal length, wherein the position of said covering is adjustable by axially displacing the thin strip along the longitudinal length of the thin strip so that the strip moves across the opening defined by said spoon-shaped trough in response to said actuating rod”.

The appendage 4 of Salerno can not be considered to be a thin strip having a longitudinal length, as recited in independent claim 17. In contrast, the appendage 4 is cup- or bowl-shaped. The jaws 13, 14 of Falk likewise can not be considered to be a thin strip.

Furthermore, the pivoting or rotational movement of the jaws of Salerno and Falk fail to disclose, teach or suggest (1) axially displacing the thin strip along the longitudinal length of the thin strip, and (2) that the strip moves across the opening defined by said spoon-shaped trough. Regarding the first reason, the appendage 4 of Salerno is arranged at the end of a lever 5, which is articulated about a transverse axis 8 (see col. 2, lines 57-62, of Salerno). When the lever is pivoted, the appendage 4 is circumferentially displaced and not axially displaced along a longitudinal axis of the cover. The pivoting of the appendage in Salerno (and the jaw of Falk) is an entirely different movement from the axial displacement of the cover recited in independent claim 8. Even though the overall movement of the tip of the appendage 4 has a component in the axial direction relative to the rod of the medical device on which the appendage 4 is mounted, the

circumferential movement of the appendage 4 cannot be considered to be an axial displacement "along the longitudinal length of the cover", as recited in independent claim 17.

Furthermore, the pivoting action of the lever does not move the appendage 4 across the opening of the trough in Salerno. Rather, the appendage 4 is moved onto the other appendage 2. Accordingly, the pivotal movement of the appendage 4 of Salerno cannot be considered to be moving across the opening defined by the trough.

Conclusion

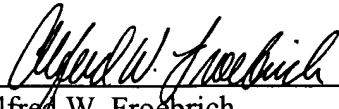
In view of the above remarks, the combined teachings of Salerno and Falk fail to teach or suggest the recited limitations of independent claims 8 and 17. Accordingly, the rejection of independent claims 8 and 17 should be withdrawn.

Dependent claims 10-16, and 18-19, each being dependent on one of independent claims 1, 8, and 14, are deemed to be allowable for at least the same reasons expressed above with respect to independent claims 1, 8, and 14, as well as for the additional recitations contained therein.

The application is now respectfully deemed to be in condition for allowance, and early notice to that effect is solicited.

Any additional fees or charges required at this time in connection with the application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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